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EXAMINER	
RAMAKRISHNAIAH, MELUR	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 12

Application Number: 09/827,547
Filing Date: April 06, 2001
Appellant(s): BARNETT, HOWARD S.

W. Thomas Timmons
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9-2-2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

There are no amendments after final.

(5) Summary of Invention

The summary of invention is not contained in the brief. The summary of the invention is shown in pages 1-3 of Appellant's specification and the Board's attention is respectfully directed to Pages 1-3 of Appellant's specification for a correct summary of the invention.

(6) Issues

Appellant does not provide any statement of issues.

(7) Grouping of Claims

The rejection of claims 1-5 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,767,897	Howell	6-16-1997
5,489,938	Maruyama et al.	2-6-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1- 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell (US PAT:5,767,897). in view of Maruyama et al. (US PAT: 5489,938, hereinafter Maruyama).

Regarding claim 1, Howell discloses a system for teleconferenceing presentation by a presenter, comprising in combination: a cart forming podium (22, fig. 1, col. 3 lines 17-18), a computer located (32, figs. 1-2) in or on the cart (col. 3 lines 47-53), a touch panel interface (27, figs. 1-2) with the computer, positioned in the cart, visible to the presenter (28, fig. 2, col. 3 lines 65-67, col. 4 lines 1-14), and a CODEC (30, fig. 2) operationally attached to the computer, wherein the computer, the touch panel and the CODEC can be used without removing from the cart (fig. 1, col. 3 lines 40-44).

Regarding claims 2-5, Howell further teaches the following: a first camera (76, figs. 1-2) for taking a video image of the presenter, the first camera (76, fig. 1) is mounted on the cart, wherein the first camera can be used without removing from the cart (col. 4 lines 14-15), a second camera (70, fig. 1) located on or in the cart, for imaging of documents, wherein second camera can be used without removing it from the cart (col. 4 lines 18-19), projector in (22, fig. 1) associated with the cart and a screen, wherein the projector projects images from the first or second camera to the screen, wherein projector can be used without disassociating from the cart (col. 7 lines 15-67, col. 8 lines 1-6).

Howell differs from claimed invention in that he does not explicitly teach a portable system for teleconferencing.

However, Maruyama discloses a television teleconference system which teaches portable system for teleconferencing (fig. 3, col. 4 lines 16-31).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Howell's system to provide for portable system for teleconferencing as this arrangement would provide easy portability of the teleconferencing system, thus reducing the time and labor necessary for transportation of the system as taught by Maruyama.

(11) Response to Argument

Appellant as part of his arguments describes the some of the features of the Howell patent (5,767,897) on pages 1-2 of his Appeal brief response. In particular, Appellant remarks, on paragraph one of page 2 of his appeal brief response that "the Howell patent does not address transportability of videoconferencing from one room to

another. Although "podium" 23 (fig. 1) appears to some sort of casters, they are not numbered or mentioned in the patent. The disclosure ... Assuming that what is shown are casters are wheels, a podium with wheels still does not a "cart" make". Regarding this Appellant attention is drawn to the fact that claims 1-5 are rejected under 35 U.S.C 103(a) over Howell (US PAT: 5,767, 897) in view of Maruyama et al. (US PAT: 5,489,938, hereinafter Maruyama). Final office action listed above clearly states the following: Howell differs from claimed invention in that he does not explicitly teach a portable system for teleconferencing.

However, Maruyama discloses a television teleconference system which teaches portable system for teleconferencing (fig. 3, col. 4 lines 16-31).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Howell's sysyem to provide for portable system for teleconferencing as this arrangement would provide easy portability of the teleconferencing system, thus reducing the time and labor necessary for transportation of the system as taught by Maruyama.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In view of this Examiner submits that prima facie case of obvious rejection under 35 U.S.C 103(a) has been made regarding claims 1-5, and Appellant arguments have failed to overcome this rejection.

Appellant further continues his discussion of Howell reference in paragraphs 2-4 of page 2 of his appeal brief response. In particular, Appellant remarks that "This similarity is where these inventions end. The Howell patent discloses an apparatus, which contains a controller. The controller has specific attributes such as a preview display, presentation display, and control section".

Appellant further remarks "The present patent application addresses the portability of device, and how to contain the proper equipment in an easily portable configuration. The present application could actually use the controller that is contained with in the Howell patent or use a controller of different design. The equipment of the Howell patent is not a requirement for the operation of the device disclosed in the present patent application. Further, the drawings ...using multiple carts or cabinets to house all the equipment necessary for a videoconference". Regarding this, as can be seen from Appellant's above remarks, Appellant is giving subjective analysis of his invention compared to Howell reference, which is self-serving without actually pinpointing what limitations are not addressed by the rejection set forth in the final office action set forth above. Therefore, Examiner submits that rejection of claims 1-5 under 35 U.S.C 103(a) over Howell in view of Maruyama is valid.

Appellant further lists on first paragraph of page 3 of his appeal brief response some of the limitations of his amended claims. Regarding this all these claim limitations are addressed in the final rejection set forth in the office action, which is listed above. For instance, the following is set forth in the office action which is repeated here: Regarding claim 1, Howell discloses a system for teleconferencing presentation by a presenter, comprising in combination: a cart forming podium (22, fig. 1, col. 3 lines 17-18), a computer located (32, figs. 1-2) in or on the cart (col. 3 lines 47-53), a touch panel interface (27, figs. 1-2) with the computer, positioned in the cart, visible to the presenter (28, fig. 2, col. 3 lines 65-67, col. 4 lines 1-14), and a CODEC (30, fig. 2) operationally attached to the computer, wherein the computer, the touch panel and the CODEC can be used without removing from the cart (fig. 1, col. 3 lines 40-44).

Regarding claims 2-5, Howell further teaches the following: a first camera (76, figs. 1-2) for taking a video image of the presenter, the first camera (76, fig. 1) is mounted on the cart, wherein the first camera can be used without removing from the cart (col. 4 lines 14-15), a second camera (70, fig. 1) located on or in the cart, for imaging of documents, wherein second camera can be used without removing it from the cart (col. 4 lines 18-19).projector in (22, fig. 1) associated with the cart and a screen, wherein the projector projects images from the first or second camera to the screen, wherein projector can be used without disassociating from the cart (col. 7 lines 15-67, col. 8 lines 1-6).

Howell differs from claimed invention in that he does not explicitly teach a portable system for teleconferencing.

However, Maruyama discloses a television teleconference system which teaches portable system for teleconferencing (fig. 3, col. 4 lines 16-31).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Howell's system to provide for portable system for teleconferencing as this arrangement would provide easy portability of the teleconferencing system, thus reducing the time and labor necessary for transportation of the system as taught by Maruyama.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In view of this, Examiner submits that a prima facie case of obvious rejection has been set forth above and Appellant arguments have failed to overcome this rejection.

Appellant further lists some of the features of Maruyama et al. (US PAT: 5,489,938, hereinafter Maruyama) reference in pages 3-5 of his appeal brief response and then he remarks on second paragraph of page 4 of his appeal brief response that "The present patent disclosure does not contain any of these components. The system disclosed does not necessarily contain a cabinet with multiple compartments. In one of the preferred embodiments, the device contains only one compartment". Appellant

remarks above does not address the claim limitations of his invention with respect to teachings of the Maruyama reference, and whether or not Maruyama reference teaches these limitations. As a matter of fact Maruyama reference is used for its teachings of portable system for teleconferencing (fig. 3 col. 4 lines 16-31) which is not explicitly taught by Howell reference. Appellant's remarks above do not argue about this teaching.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Therefore, Examiner submits that prima facie case of obviousness rejection has been set forth in the office action using above references and Appellant arguments have failed to overcome this rejection.

Appellant further remarks on page 4-5 of his appeal brief reference, regarding Maruyama reference are in similar vein as above. In particular, Appellant remarks on first paragraph of page 5 of his appeal brief reference that "the fundamental difference in design of the cabinet in Maruyama et al. patent and the cart in the present patent application would be that the configuration in the present patent application is designed to be used by an instructor as the lectern for teaching while this was never conceived on the Maruyama et al. patent. In the present patent application, all components are in

easy reach". Regarding this, Examiner submits that Appellant remarks above are nothing to do with claim limitations of his invention and further Appellant has failed to address the teachings of Maruyama et al. patent with respect to portable system for teleconferencing for which it is sited and its relevance to his claim limitation such as portable system for teleconference.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In view of this, Examiner submits that using the above references Examiner has made prima facie case of obviousness rejection and Appellant arguments have failed to overcome this rejection.

Appellant remarks on pages 6-7 are noted, and do not address appellants claim limitations with respect to Howell and Maruyama teachings, but he lists what Appellant thinks is so revolutionary about his invention. As such Examiner submits that Appellant has failed to overcome prima facie case of obviousness rejection under 35 U.S.C over Howell in view of Maruyama.

Conclusion

For the above reasons, the examiner respectfully submits that a ***prima facie*** case of obviousness of the claimed invention has been set forth in the Final office action and appellant(s) have failed to overcome the ***prima facie*** case of obviousness under 35 U.S.C 103(a). Accordingly, it is believed that final rejection under 35 U.S.C 103(a) is proper and Board of Patent Appeals and Interferences is therefore respectfully urged to affirm the Examiner's rejection(s).

Respectfully submitted.

Meluv. Ramakrishnaiah

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